REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on February 7, 2007. A petition for a one month extension of time is submitted herewith. The Director is authorized to charge $120.00 for the petition for extension of time and any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112701-443 on the account statement.

Claims 1-2, 4-15 and 17-23 are pending in this application. Claims 3 and 16 were previously canceled. In the Office Action, Claims 1-2, 4-15 and 17-23 are rejected under 35 U.S.C. §112, first paragraph, and Claims 1 and 14 are rejected under 35 U.S.C. §103. In response Claims 1, 12 and 14 have been amended. This amendment does not add new matter. In view of the amendment and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

Claim 12 has been amended for clarification purposes

In the Office Action, Claims 1, 2, 4-15 and 17-23 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. More specifically, the Patent Office asserts that independent Claims 1 and 14 fail to comply with the written description requirement with respect to the recitations "having a predetermined volume," "*allowing* compressed gas to displace" and "for restoring atmospheric pressure in the volume of the chamber for filling of said volume from the reservoir." Applicants respectfully disagree.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. An applicant shows possession of the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. There is no *in haec verba* requirement. Claim limitations can be supported through express, implicit or inherent disclosure.

In response, Applicants have amended Claims 1 and 14 to recite, in part, that the chamber has a volume. The amendment is supported in the specification, for example, at page 2, lines 14-18. Moreover, the skilled artisan would understand that a chamber inherently has a volume.

Applicants respectfully submit that the phrases "*allowing* compressed gas to displace" and "for restoring atmospheric pressure in the volume of the chamber for filling of said volume

from the reservoir" were sufficiently disclosed in the specification and believe that one skilled in the relevant art, at the time the application was filed, would recognize that Applicants had possession of the claimed invention. For example, the specification clearly states that ambient air/atmospheric pressure is used to empty the chamber and the piston is "displaced by compressed gas." See, specification, page 2, lines 20-24; page 4, lines 5-10. In addition, the specification, specifically teaches that:

> When the consumer wishes to make himself a coffee, the valve (4) is opened and placed in communication with the ambient air. As the side (5a) empties of air, the spring (17) relaxes and draws water from the water reservoir (1) to the side (5b). When the side (5b) is full, the valve (4) is placed in a position in which there is a link to the compressed-gas reservoir (2): the gas expands by virtue of (3) and displaces the piston (16) so as to displace the mass of water in the side (5b). The water passes via the non-return valve (18) into the heating system (7) and via the extraction head (10). The coffee is delivered to the cup (15). The machine is then ready for the next extraction.

See, specification, page 4, lines 1-13 (emphasis added).

The specification also teaches:

> When the consumer wishes to make himself a coffee, he disengages the trigger (32) in the direction of the arrow B, which allows the spring (33) to relax (FIG. 3). The piston (30) rises in the direction of the arrow A. The air present at (37) exits in the direction of the arrow C in the conduit (28) and is evacuated via the valve (27) to the outside (arrow E). The water in the reservoir (20) is drawn through the valve (22) at (38). When the piston (30) rises, the valve release (35) pushes the rod (34) of the valve in the direction of the arrow F until there is no longer any air at (37) and a maximum volume is achieved for (38). At this point, the valve (27) rocks in order to allow the compressed gas to enter via the release (24) through the conduit (28) in order to push the piston (30). The volume of hot water at (38) opens the valve (36), arrives at the capsule (26) and the coffee flows into the cup (40). During extraction, the piston draws the rod (34) downward in the direction of the arrow G. At the end of the piston's travel (FIG. 5), the valve (27) restores atmospheric pressure in the volume (37) and the trigger (32) again immobilizes the piston with the compressed spring (33). The machine is then ready for a further extraction. Provision may be made for a reservoir (20) having a volume of the order of 1 or 2 litres. The compressed-gas reservoir (23) normally has a volume of the order of . . . L. The volume (38) corresponds to a cup volume of the order of 100 cc.

See, specification, page 4, line 33 to page 5, line 22 (emphasis added).

Applicants have also amended Claims 1 and 14 to recite the positions that the valve can be utilized in for allowing, for example, compressed gas or ambient gas/atmospheric pressure to fill the chamber. As a result, Applicants respectfully submit that the skilled artisan would understand that Applicants had possession of the claimed subject matter at the time of filing the application.

Based on at least these noted reasons, Applicants respectfully submit that Claims 1-2, 4-15 and 17-23 fully comply with 35 U.S.C. §112, first paragraph.

Accordingly, Applicant respectfully requests that the rejection of Claims 1-2, 4-15 and 17-23 under 35 U.S.C. §112 be withdrawn.

In the Office Action, Claims 1 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 00/02081 to Gschwend ("*Gschwend*") in view of U.S. Patent No. 3,918,355 to Weber ("*Weber*"). Applicants believe this rejection is improper and respectfully traverse it for at least the reasons set forth below.

Independent Claims 1 and 14 recite, in part, a device comprising a chamber having a volume coupled to a water reservoir, a piston in the chamber that is displaced by a gas under pressure and a valve selectively allowing compressed gas to displace the piston so as to empty the chamber of water. For example, in an embodiment, a valve connected to the chamber is opened and placed in communication with the ambient air. The piston in the chamber is displaced by a spring that relaxes and draws water from a water reservoir into the chamber. Once the chamber is filled with water, the valve is placed in a position in which there is a link to a compressed-gas reservoir and the chamber. The gas expands against the piston in the chamber and displaces the piston so as to displace the mass of water in the side of the piston. The water passes by non-return valve into a heating system and via an extraction head thereby delivering coffee to a cup. The device is then ready for the next extraction. In contrast, Applicants respectfully submit that *Gschwend* and *Weber* are deficient with respect to the present claims.

Applicants respectfully submit that there is no reason to combine *Gschwend* and *Weber* to obtain the present claims because the mode of operation of the device in each reference is completely different. Each reference must be considered as a whole and those portions teaching against or away from each other and/or the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). "A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998), quoting, *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

Gschwend is directed toward a coffee machine for mobile use using compressed air to move liquid from a reservoir to a brewing unit. The liquid is, therefore, in direct contact with the

compressed air with no intermediate device used to move the liquid from the reservoir to the brewing unit.

In contrast to *Gschwend*, *Weber* is directed toward an infusion apparatus where liquid is pushed from a first chamber to a second chamber by a weighted piston that specifically designed to be actuated by the force of gravity. See, *Weber*, column 4, lines 53-59. In *Weber*, the piston is in direct contact with the liquid as the force of gravity acts on the weight of the piston forcing the liquid under substantially constant pressure through the passage into the second chamber. Although the apparatus of *Weber* utilizes a piston to empty the first chamber, the piston is entirely driven by the force of gravity as opposed to being driven by compressed gas (*Gschwend*), which teaches away from the combination.

Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). For example, *Gschwend* uses compressed air to empty the first chamber whereas *Weber* uses the force of gravity to move a piston to empty the reservoir. In fact, the Patent Office has provided no attempt at how the weighted piston of *Weber* could be functionally incorporated into the machine of *Gschwend*. Consequently, the skilled artisan would have no motivation to combine the cited references to arrive at the present claims.

Applicants also respectfully submit that, even if combinable, all of the claimed elements are not taught or suggested by the cited references. For example, *Gschwend* fails to disclose or suggest a piston in the chamber that is displaced by the gas under pressure as required, in part, by Claims 1 and 14. *Gschwend* also fails to disclose or suggest a valve selectively allowing compressed gas to displace the piston so as to empty the chamber of water as required, in part, by Claims 1 and 14. Further, *Gschwend* fails to disclose or suggest a chamber having a volume coupled to a water reservoir as required, in part, by Claims 1 and 14. Instead, *Gschwend* discloses a coffee machine for mobile use using compressed air to move a liquid directly from a reservoir to a brewing unit, whereby the entire reservoir must be kept under constant gas pressure to be able to deliver liquid into the brewing chamber.

Weber also fails to disclose or suggest a piston in the chamber that is displaced by a gas under pressure as required, in part, by Claims 1 and 14. *Weber* also fails to disclose or suggest a valve selectively allowing compressed gas to displace the piston so as to empty the chamber of

water as required, in part, by Claims 1 and 14. Further, *Weber* fails to disclose or suggest a chamber having a volume coupled to a water reservoir as required, in part, by Claims 1 and 14. Instead, *Weber* is direct toward an infusion apparatus for dispensing a quantity of a heated liquid where liquid is pushed from a first chamber into a second chamber by the force of a weighted piston on the liquid of the first chamber.

For at least the reasons discussed above, the combination of *Gschwend* and *Weber* is improper. Moreover, even if combinable, *Gschwend* and *Weber* do not teach, suggest, or even disclose all of the elements of Claims 1 and 14 and Claims 2, 4-15 and 17-23 that depend from Claims 1 and 14, and thus, fail to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the rejection of Claims 1-2, 4-15 and 17-23 under 35 U.S.C. §103 be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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